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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,932	03/19/2001	Kazuhide Adachi	2313.65519	9648

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EXAMINER

BARRETT, SUZANNE LALE DINO

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

*3 mos. extension
+ filed CIP*

SW

Office Action Summary

Application No.

09/811,932

Applicant(s)

ADACHI, KAZUHIDE

Examiner

Suzanne Dino Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it should be in one paragraph form, and also, the grammar is awkward and incorrect (for example, see lines 7-8). Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities: on page 4, the last line is redundant; on page 5, the grammar is awkward and incorrect, especially, lines 3-7; on page 7, line 13, delete "will" at the end of the line.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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5. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to provide an adequate written description of the invention since many of the terms utilized in the disclosure seem to be incorrect concepts, i.e. "disbursement information" as recited in the specification does not seem to refer to "disbursements" in the generally accepted definition, and further, it is unclear what is being disclosed—is it the selling of your demographics, a market for past purchases, or a market for future purchases? In addition, the specification lacks enablement in that it fails to describe how to compute the "value to the business" or the "value of the purchase information" (the specification needs computing disclosure on how these values will be determined). Furthermore, in this vein, how do you turn the information into bonds, warrants or securities, as claimed, if the value is not clear. In addition, the disclosed scenario does not fit the definition of a "bond", "security" or "warrant". It is unclear how you could do this with information on expected future purchases, since the real value cannot be determined. Since the purchase may never be made, it is purely speculative, and therefore, cannot be bonded, secured or warranted. These issues must be resolved by amendment to the specification and claims. Applicant is cautioned against the inclusion of new matter.

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6. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recitations are narrative in form and replete with lack of antecedent basis (the use of the term "its" is indefinite). Furthermore, the claimed limitations are ambiguous and indefinite since the processes for the value, swapping to bonds, brokering, and auction are not recited rendering the claims indefinite. Specifically, in claims 1-3, the "auction" limitations at the end of the claims are ambiguous and indefinite since the auction specifics are not disclosed.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant's claimed invention is devoid of any limitation to a practical application in the technological arts. Note that claims 1 and 3 fail to incorporate any technological art limitations and claim 2 incorporates the internet only as an alternative in line 10, "or brokered online".

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan's article in InfoWorld or Hagel's book "Net Gain" or the Shimbun article in view of Shkedy 6,260,024 or Walker et al 5,794,207.

10. The cited articles and books all disclose the market value of purchase plan information for either past purchases or future purchases. Shkedy and Walker et al disclose the well known secondary markets for future, need-based purchases, wherein the personal history or purchase information is sold at auction (secondary market) to the highest bidder. It would have been obvious to one of ordinary skill in the art to provide the well known purchase plan information commodity, discussed in the various cited articles, with a secondary market in which to sell to the highest bidder as taught by either Shkedy or Walker et al, since the purpose of the accumulation of such information is to create sales and revenue.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the cited articles and patents which disclose purchase plan information gathering and secondary markets.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 703-308-0825. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1020.

A handwritten signature in black ink, appearing to read 'SDB', is positioned above the printed name of the examiner.

Suzanne Dino Barrett
Primary Examiner
Art Unit 3676

sdb
September 3, 2003